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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/727,697

Filing Date: December 04, 2003

Appellant(s): BARNES, TED A.

John G. Fischer (Reg. No. 41,748) of Storm, LLP  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 03, 2008 appealing from the  
Office action mailed August 12, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: Co-pending application 10-778385.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

1. Claims 6 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) in view of Penning (U.S. Patent Number 5827282).
2. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241 B1) in view of Kamo et al., (Japan (Patent Number 4-133886) and Penning (U.S. Patent Number 5827282).

### **NEW GROUND(S) OF REJECTION**

3. Claims 6 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) in view of Koskinen (U.S. Patent Number 3568963).
4. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241 B1) in view of Kamo et al., (Japan (Patent Number 4-133886) and Koskinen (U.S. Patent Number 3568963).

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2001/0039850	Masui	11-2001
6062053	Ho	01-1999
6644614	Chen	05-2002
JP 4-133886	Kamo et al.	05-1992
3568963	Koskinen	03-1971

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3 & 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Masui et al., (U.S. Patent Number 6305241 B1).

Masui et al., discloses the body (34) adapted for attachment to the control bracket (124, 126, 128 & 130); the pair of substantially parallel mounting holes (44 & 52) extending through the body (34) (See Figure 1); the mounting holes (44 & 52) aligned with portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in the control bracket (124, 126, 128 & 130); the radial relief (60 & 120) located between the parallel mounting holes (44 & 52);

the threaded accessory hole (82) in the body (34) (See Column 4, lines 23 – 24); and, wherein the body (34) is attachable to the control bracket (124, 126, 128 & 130) by location of fasteners (48 & 56) through the mounting holes (44 & 52) and control bracket portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Hole) in threaded connection with the control body (22) (See Column 4, lines 41 – 65) (See Figure 3).

Regarding claim 3, Masui et al., discloses the body (34) being generally rectangular (See Figure 3).

Regarding claim 5, Masui et al., discloses the threaded accessory hole (82) is located in substantially perpendicular relationship to the mounting holes (44 & 52) (See Figure 3).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) in view of Ho (U.S. Patent Number 6062053).

However, Masui et al., does not disclose the countersink portion that is larger in diameter than the cylinder portion.

Ho teaches the countersink portion (25) that is larger in diameter than the cylinder portion (See Figure 2)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the countersink portion that is larger in diameter than the cylinder portion as taught by Ho with the vehicle accessory mount of Masui et al., in order to enhance fastener protection.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) in view of Chen (U.S. Patent Number 6644614 B1).

However, Masui et al., does not disclose the threaded accessory hole being located between the mounting holes.

Chen teaches the threaded accessory hole (511) is located between the mounting holes (See Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the threaded accessory hole located between the mounting holes as taught by Chen with the vehicle accessory mount of Masui et al., in order to enhance multi-functional capabilities.

10. Claims 8, 9, 10, 12, 14, 17 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) in view of Kamo et al., (Japan Patent Number 4-133886).

Masui et al., discloses the body (34) adapted for attachment to the control bracket (124, 126, 128 & 130); the pair of substantially parallel mounting holes (44 & 52) extending through the body (34); the mounting holes (44 & 52) aligned with portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in the control bracket (124, 126, 128 & 130); the threaded accessory hole (82) in the body (34) (See Column 4, lines 23 – 24); and wherein the body (34) is attachable to the control bracket (124, 126, 128 & 130) by location of fasteners (48 & 56) through the mounting holes (44 & 52) and control bracket portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in threaded connection with the control body (22) (See Column 4, lines 41 – 65) (See Figure 3).

However, Masui et al., does not disclose the pair of hollow standoffs locatable between the mounting holes and bolt portals in the control bracket.

Japanese reference teaches the pair of hollow standoffs (33) (See Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pair of hollow standoffs locatable between the mounting holes and bolts portals in the control bracket, since it has been held that mere duplication of the essential working parts of the device involves only routine skill in the art.

Regarding claim 9, Masui et al., discloses the body (34) being generally rectangular (See Figure 3).

Regarding claim 10, Masui et al., discloses the radial relief (60) located between the parallel mounting holes (44 & 52) (See Figure 3).

Regarding claim 12, Masui et al., discloses the threaded accessory hole (82) is located in substantially perpendicular relationship to the mounting holes (44 & 52).

Regarding claim 14, Masui et al., does not disclose the inside diameter of each hollow standoff is substantially the same as the inside diameter of the cylinder portion of the mounting holes.

Japanese reference teaches the inside diameter of each hollow standoff is substantially the same as the inside diameter of the cylinder portion of the mounting holes (See Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the inside diameter of the cylinder portion of the mounting holes as taught by the Japanese reference with the vehicle accessory mount of Masui et al., in order to enhance flush fittings.

Regarding claim 17, Masui et al., does not disclose wherein each standoff is locatable in the recess on the control bracket.

Japanese reference teaches the standoff (33) locatable in the recess on the control bracket (28) (See Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the standoff locatable in the recess on the control bracket as taught by the Japan reference with the vehicle accessory mount of Masui et al., in order to enhance flush fittings.

Regarding claim 19, Masui et al., discloses the body (34) adapted for attachment to the control bracket (124, 126, 128 & 130); the threaded accessory hole (82) in the body (34) (See Column 4, lines 23 – 24); the pair of substantially parallel mounting holes (44 & 52) extending through the body (34); the mounting holes (44 & 52) aligned with portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in the control bracket (124, 126, 128 & 130); and wherein the body (34) is attachable to the control bracket (124, 126, 128 & 130) by location of fasteners (48 & 56) through the mounting holes (44 & 52) and control bracket portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in threaded connection with the control body (22) (See Column 4, lines 41 – 65) (See Figure 3).

However, Masui et al., does not disclose wherein each standoff is locatable in the recess on the control bracket.

Japanese reference teaches the standoff (33) locatable in the recess on the control bracket (28) (See Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the standoff locatable in the recess on the control bracket as taught by the Japan reference with the vehicle accessory mount of Masui et al., in order to enhance flush fittings.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) and Kamo et al., (Japan Patent Number 4-133886) as applied to claim 8 above, and further in view of Chen (U.S. Patent Number 6644614 B1).

However, Masui et al., does not disclose the threaded accessory hole being located between the mounting holes.

Chen teaches the threaded accessory hole (511) is located between the mounting holes (See Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the threaded accessory hole located between the mounting holes as taught by Chen with the vehicle accessory mount of Masui et al., in order to enhance multi-functional capabilities.

12. Claim 13 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) and Kamo et al., (Japan Patent Number 4-133886) as applied to claim 8 above, and further in view of Ho (U.S. Patent Number 6062053).

However, Masui et al., does not disclose the countersink portion that is larger in diameter than the cylinder portion.

Ho teaches the countersink portion (25) that is larger in diameter than the cylinder portion (See Figure 2)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the countersink portion that is larger in diameter than the cylinder portion as taught by Ho with the vehicle accessory mount of Masui et al., in order to enhance fastener protection.

Regarding claim 18, Masui et al., does not disclose each standoff locatable in the countersunk portion on the control bracket.

Ho teaches standoffs capable locatable in the countersunk portion (25) on the control bracket (20) (See Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make standoffs capable locatable in the countersunk portion on the control bracket as taught by Ho with the vehicle accessory mount of Masui et al., in order to enhance fastener protection

#### **NEW GROUND(S) OF REJECTION**

13. Claims 6 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241) in view of Koskinen (U.S. Patent Number 3568963).

Masui et al., discloses the body (34) adapted for attachment to the control bracket (124, 126, 128 & 130); the pair of substantially parallel mounting holes (44 & 52) extending through the body (34); the mounting holes (44 & 52) aligned with portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in the control bracket (124, 126, 128 & 130); and wherein

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the body (34) is attachable to the control bracket (124, 126, 128 & 130) by location of fasteners (48 & 56) through the mounting holes (44 & 52) and control bracket portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in threaded connection with the control body (22) (See Column 4, lines 41 – 65) (See Figure 3).

However, Masui et al., does not disclose the ball stud attached to the threaded accessory hole.

Koskinen teaches the ball stud (30) attached to the threaded accessory hole (See Figures 1 & 2).

It would have been obvious to one having ordinary skill in the art at the invention was made to make the ball stud attached to the threaded accessory hole as taught by Koskinen with the vehicle accessory mount of Masui et al., in order to enhance accessory attachments.

14. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al., (U.S. Patent Number 6305241 B1) in view of Kamo et al., (Japan (Patent Number 4-133886) and Koskinen (U.S. Patent Number 3568963).

Masui et al., discloses the body (34) adapted for attachment to the control bracket (124, 126, 128 & 130); the pair of elongated mounting holes (44 & 52) extending through the body (34) (See Figure 1); the mounting holes (44 & 52) aligned with portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in the control bracket (124, 126, 128 & 130); and, wherein the body (34) is attachable to the control bracket (124, 126, 128 & 130) by location of fasteners (48 & 56) through the mounting holes (44 & 52) and control

bracket portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in threaded connection with the control body (22) (See Column 4, lines 41 – 65) (See Figure 3).

However, Masui et al., does not disclose the pair of hollow standoffs locatable between the mounting holes and portals.

Japanese reference teaches the pair of hollow standoffs (33) (See Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pair of hollow standoffs locatable between the mounting holes and portals, since it has been held that mere duplication of the essential working parts of the device involves only routine skill in the art.

However, Masui et al., does not disclose the ball stud attached to the threaded accessory hole.

Koskinen the ball stud (30) attached to the threaded accessory hole (See Figures 1 & 2).

It would have been obvious to one having ordinary skill in the art at the invention was made to make the ball stud attached to the threaded accessory hole as taught by Koskinen with the vehicle accessory mount of Masui et al., in order to enhance accessory attachments.

Regarding claim 16, Masui et al., as modified does not disclose the ball stud attached to the threaded accessory hole.

Penning teaches the ball stud (9) attached to the threaded accessory hole (6) (See Figures 1 & 2).

It would have been obvious to one having ordinary skill in the art at the invention was made to make the ball stud attached to the threaded accessory hole as taught by Penning with the vehicle accessory mount of Masui et al., in order to enhance accessory attachments.

**(10) Response to Argument**

1. Appellant argues, the preamble breathes life and meaning into each claim so that the preambles should be accorded full weight in assessing patentability over the cited prior art.

In addition, appellant relies on Griffin v. Bertina, 285 F. 3d 1029; 2002, U.S. App. LEXIS 5644; 62 U.S.P.Q. 2d (BNA) 1431 (Fed. Cir. 2002) and Boehringer Ingelheim Vet Medica Inc. v. Schering Plough Corp. et al., 20 F. 3d 1339; 2003 U.S. App. LEXIS 3232; 65 U.S.P.Q. 2d (BNA) 1961 (Fed. Cir. 2003) to support the argument.

In response to appellant arguments, the preamble filed on June 12, 2008 recites: "A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body".

The phrase "adapted for" in the preamble sets forth functional and intended use language.

Meaning, the positively claimed "Vehicle Accessory Mount" recited in the preamble filed on June 12, 2008 is capable of being attached to a control bracket of a handle-barred vehicle throttle.

In addition, the same positively claimed "Vehicle Accessory Mount" recited in the preamble filed on June 12, 2008 is also capable of being attached to a clutch control body, since appellant recites "OR" in the preamble.

Therefore, appellant positively claims "The Vehicle Accessory Mount" as the present invention that is adapted for "OR" capable of attachment to numerous structures such as a control bracket of a handle-barred vehicle throttle or clutch control body.

Moreover, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim 1, line 8 recites: "wherein the body is attachable to the control bracket by location".

Therefore, claim 1 recites functional language of how the body is attached not limiting to any additional structure.

Therefore, Masui et al., which teaches all of the structure: (i.e. the body, the pair of mounting holes, the radial relief of or threaded accessory hole), is capable of being attachable to the control bracket.

Furthermore, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Masui et al., which is capable

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of being used in the intended manner, i.e., a vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle OR clutch control body. (see M.P.E.P. 2111).

2. Appellant argues, Masui does not disclose each and every feature recited in Claim 1.

Examiner disagrees, Masui teaches the body (34) adapted for attachment to the control bracket (124, 126, 128 & 130); the pair of substantially parallel mounting holes (44 & 52) extending through the body (34) (See Figure 1); the mounting holes (44 & 52) aligned with portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Holes) in the control bracket (124, 126, 128 & 130); the radial relief (60 & 120) located between the parallel mounting holes (44 & 52); the threaded accessory hole (82) in the body (34) (See Column 4, lines 23 – 24); and, wherein the body (34) is attachable to the control bracket (124, 126, 128 & 130) by location of fasteners (48 & 56) through the mounting holes (44 & 52) and control bracket portals (1<sup>st</sup> & 2<sup>nd</sup> Threaded Blind Hole) in threaded connection with the control body (22) (See Column 4, lines 41 – 65) (See Figure 3).

In addition, appellant argues, the element #34 of Masui is not "a body adapted for attachment to the control bracket.

Claim 1, line 3 recites: "a body adapted for attachment to the control bracket".

The phrase "adapted for" in claim 1, line 3 sets forth functional and intended use language.

Meaning, appellant is positively claiming "a body" that is capable of or adapted for attachment and provides no positive recitation to the control bracket and is not claiming the combination of the control bracket and the body.

Masui teaches a vehicle accessory mount body (34) that is capable of OR adapted for attachment (See Figure 3).

Therefore, if a prior art structure is capable of performing the intended use as recited in the preamble and claim 1, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner) and cases cited therein. See also MPEP § 2112 - § 2112.02.

Appellant does not set forth any structural limitations to clearly identify or further define the body.

Appellant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The limitations set forth in claim 1 should be descriptive enough to clear identify applicant's invention.

Masui teaches the body (34) being capably adapted for attachment to the control bracket (124, 126, 128 & 130) (See Column 4, lines 41 – 65) (See Figure 3).

Therefore, Masui meets the "a body adapted for attachment to the control bracket" limitations set forth in the independent claims.

3. Appellant argues, Ho does not supply the deficiencies of Masui, which also lacks a "body" that is "adapted for" attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle.

Examiner disagrees, Ho does not make up for deficiencies of Masui.

However, Ho was combined with Masui because it would have been obvious to one having ordinary skill in the art to make the vehicle accessory mount comprising countersink portions that are larger in diameter than the cylinder portion as taught by Ho with the "vehicle accessory mount" of Masui et al., in order to enhance fastener protection.

4. Appellant argues, Chen does not show a body that is "adapted for" attachment to the control bracket of a handle-barred vehicle.

Examiner disagrees, Chen teaches a "vehicle accessory mount" having a "body" that is "adapted for" attachment and having a threaded accessory hole.

Furthermore, Chen teaches a threaded accessory hole located between a pair of substantially parallel mounting holes.

Therefore, Chen was combined with Masui because it would have been obvious to one having ordinary skill in the art to make the vehicle accessory mount capable of

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having a threaded accessory hole as taught by Chen with the vehicle accessory mount of Masui et al., in order to enhance multi-functional capabilities.

5. Appellant's arguments with respect to claims 6 & 7 have been considered but are moot in view of the new ground(s) of rejection.

6. Appellant argues, Kamo et al., (Japan Patent Number 4-133866) does not show a body that is "adapted for" attachment to the control bracket.

Examiner disagrees, Kamo et al., (Japan Patent Number 4-133866) teaches the vehicle accessory mount body (28) is "capable of" or "adapted for" attachment to the control bracket (20) (See Figure 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the standoffs (33) of Japan ('886) with the vehicle accessory mount of Masui et al., in order to enhance reliable anchoring.

Appellant further argues, Masui et al., does not teach or suggest a body adapted for attachment to a control bracket of a control body of a handle-barred vehicle.

Examiner disagrees, Masui et al., teaches the handlebar adapted for mounting a bicycle display (See Title). In addition, Masui et al., teaches the body (34 & 34) that is "capable of" or "adapted for" for attachment to a control bracket (124, 126, 128 & 130) of a control body (22) of a handle-barred vehicle (18) (See Figure 1).

Furthermore, appellant recites "a body adapted for" (See page 16, line 27). The phrase "adapted for" evokes functional language which implies the purpose of a process or the intended use of a structure.

Therefore, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Masui et al., which is capable of being used in the intended manner, i.e., a body adapted for attachment to a control bracket of a control body of a handle-barred vehicle (see M.P.E.P. 2111).

Moreover, independent claim 8 recites: "A vehicle accessory mount "adapted for" attachment to a control bracket of a handle-barred vehicle throttle OR clutch control body", comprising...

The preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Appellant does not provide positive recitation pertaining to "a control bracket of a handle-barred vehicle throttle OR clutch control body" in the preamble.

Therefore, no patentable weight has been given to the "control bracket of a handle-barred vehicle throttle OR clutch control body".

7. Appellant argues, Masui in view of Chen does not show a body that is "adapted for attachment to the control bracket" of a handle-barred vehicle.

Examiner disagrees, Chen discloses an accessory mount (See Figure 2) comprising the body (51) having the accessory mounting hole located between two threaded mounting holes that is "adapted for attachment".

Appellant recites "a body adapted for" (See page 17, line 8). The phrase "adapted for" evokes functional language which implies the purpose of a process or the intended use of a structure.

Therefore, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Masui et al., in view of Chen which is capable of being used in the intended manner, i.e., a body adapted for attachment to a control bracket of a control body of a handle-barred vehicle (see M.P.E.P. 2111).

Furthermore, claim 11 depends from independent claim 8 which recites: "A vehicle accessory mount "adapted for" attachment to a control bracket of a handle-barred vehicle throttle OR clutch control body", comprising...

The preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

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F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88

USPQ 478, 481 (CCPA 1951).

Appellant does not provide positive recitation pertaining to "a control bracket of a handle-barred vehicle throttle OR clutch control body" in the preamble.

Therefore, no patentable weight has been given to the "control bracket of a handle-barred vehicle throttle OR clutch control body".

8. Appellant argues, Ho fails to teach or suggest features of claims 13 and 18.

Examiner disagrees, teaches a vehicle accessory mount (See Figure 1) having a body (20) that is "adapted for" attachment (See Figures 1 & 8).

Furthermore, Ho also teaches a vehicle accessory mount (See Figure 2) comprising countersunk portion (25) that is larger in diameter than the cylinder portion (See Figure 2) on the control bracket (26) (See Figure 2).

Appellant recites "a body adapted for" (See page 18, line 2). The phrase "adapted for" evokes functional language which implies the purpose of a process or the intended use of a structure.

Therefore, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Masui et al., in view of Ho which is capable of being used in the intended manner, i.e., a body adapted for attachment to a control bracket of a control body of a handle-barred vehicle (see M.P.E.P. 2111).

In addition, appellant does not set forth any structural limitations to clearly identify or further define the body.

Appellant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The limitations set forth in claim 1 should be descriptive enough to clearly identify applicant's invention.

Ho teaches the body (20) being capably adapted for attachment to the control bracket (26)(See Figure 2).

Therefore, Masui meets the "a body adapted for attachment to the control bracket" limitations set forth in the independent claims.

Furthermore, claims 13 and 18 depends from independent claim 8 which recites: "A vehicle accessory mount "adapted for" attachment to a control bracket of a handle-barred vehicle throttle OR clutch control body", comprising...

The preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Appellant does not provide positive recitation pertaining to "a control bracket of a handle-barred vehicle throttle OR clutch control body" in the preamble.

Therefore, no patentable weight has been given to the "control bracket of a handle-barred vehicle throttle OR clutch control body".

9. Appellant's arguments with respect to claims 15 & 16 have been considered but are moot in view of the new ground(s) of rejection.

10. In response to the Declaration of Ted A. Barnes, the declaration is not related to any of the art rejections as set forth.

Moreover, in the appeal brief, appellant asserts that the declaration shows indicia of non-obvious, namely copying by others and commercial success.

With respect to commercial success – mere recitation of sales figures is insufficient evidence with respect to copying.

According to MPEP 716.06, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for patentees ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F. 2d 1015, 226 USPQ 881 (Fed. Cir. 1985).

Therefore, the declaration is not persuasive.

#### **(11) Related Proceeding(s) Appendix**

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/L. L. V./

Examiner, Art Unit 3782

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/KAREN M. YOUNG/

Director, Technology Center 3700

Conferees:

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/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724

/Nathan J. Newhouse/

Supervisory Patent Examiner, Art Unit 3782